

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Art Unit : 3682  
Examiner : James Pilkington  
Appln. No. : 10/820,424  
Applicants : Robert A. De Jonge et al.  
Filing Date : April 8, 2004  
Confirmation No. : 8844  
For : VEHICLE SHIFTER

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

APPLICANT'S REPLY UNDER 37 C.F.R. § 1.193

This is in reply to Examiner's Answer dated as mailed July 24, 2008.

Items (1-5):

The Examiner has agreed that these items are acceptable as listed in the Appeal Brief.

Item (6): Grounds of Rejection to Be Reviewed Upon Appeal

The Examiner's Answer stated that "Appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct." However, changes with respect to the status of claim 30 and the numbering of claim 29 (incorrectly 30) were made in the Examiner's Answer.

Item (7): Claims Appendix

The Examiner agreed that a correct copy of the appealed claims appears in the Appendix of the Appeal Brief.

Item (8): Evidence Relied Upon

The Examiner has correctly listed the references used to reject the claims in the present application.

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Items (9 and 10) Reply to Examiner's Grounds of Rejection and Arguments:

The Applicants' Appeal Brief stands, and is incorporated herein in its entirety. The following comments are intended to directly reply to the Examiner's Answer. In the Examiner's Answer, the Examiner made responses to the arguments made in Applicants' Appeal Brief. These arguments will be addressed in the order presented in the Examiner's Answer.

- A. Rejection of Claims 23, 26-29, 51-57 and 59 Under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Publication No. 2004/0244524 (Filed April 15, 2003).**

Claim 23

The Applicants' argument presented in the Appeal Brief for the allowability of claim 23 stands, and is incorporated herein in its entirety. Furthermore, Applicants note that the Examiner's Answer states that "Russell discloses a shift assembly for controlling the transmission of a motor vehicle comprising . . . a position of the shift member (108)" (pages 3-4) (emphasis added). However, at page 8, the Examiner's Answer states that "the "other" within the relays of Russell detects the current operating position judging between park and another position of the transmission. This "other" is not one of the three operating parameters (ignition, position of shifter and pedal) required by the claim which makes this "other" an additional operating parameter used to determine the position of the pawl." (emphasis in original) Thus, the Examiner's Answer is believed to be inconsistent with respect to the transmission switch 108 of Russell '524.

Rather than speculating about the disclosure of Russell '524, Applicant refers to the actual teachings of Russell '524. Specifically, at paragraph [0036] Russell '524 states that "the power source 104, 106 is connected to an input of a transmission or transaxle switch 108 which indicates the position of the shifter lever assembly 14 and the present gear of the transmission. When the transmission switch 108 indicates the shifter lever assembly 14 is a

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[sic.] position other than the park position, continuity is provided from an output of the transmission switch 108 to an input of a coil 110 of a first relay 112." (emphasis added) Thus, the transmission switch 108 of Russell '524 is, in fact, the position of the shift member. Simply put, the transmission switch 108 of Russell '524 cannot be both "a position of the shift member" and "at least one vehicle operating parameter" in addition to the position of the shift member. The transmission switch 108 provides a single input to the relay 112, and it cannot therefore be two distinct inputs to a controller that actuates a powered pawl as recited in claim 23.

Russell '524 simply does not disclose" any number of sensors or switches within the vehicle." As suggested at page 8 of the Examiner's Answer. Applicant notes that "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" MPEP 2112(IV), citing *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)(quoting *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991))(emphasis added).

In summary, the control circuit 102 of Russell '524 merely provides a conventional Brake Transmission Shift Interlock ("BTSI") control, and Russell '524 does not contemplate additional control features as recited in claim 23.

#### Claim 51

The Applicants' arguments presented in the Appeal Brief for the allowability of claim 51 stand, and are incorporated herein in their entirety. Independent claim 51 is similar to independent claim 23, and recites "a controller configured to control the powered pawl mechanism based at least in part upon at least one vehicle operating parameter *other than* the position of a brake pedal, a position of the shift member, and a vehicle ignition." (emphasis added)

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The transmission switch 108 of Russell '524 cannot be both a position of a shift member and another vehicle operating parameter other than the position of the shift member. The assertion in the Examiner's Answer that transmission switch 108 could provide two different inputs to a controller is speculative and contrary to the actual disclosure of Russell '524.

### Conclusion

Each appealed claim recites unique features for controlling a powered pawl of a shifter that are not disclosed in any of the cited references and it would not have been obvious to modify the cited references to include the recited features of the appealed claims. The references upon which the Examiner relies in the Examiner's rejection of the twice rejected claims do not disclose or suggest the above-noted features of the finally rejected claims. Applicants' invention provides unique results that are not contemplated by the prior art, and therefore represents a significant advancement in the art. Applicants earnestly request that the Examiner's rejection of claims 23-29 and 51-59, inclusive, be reversed, and that the application be passed to issuance forthwith.

Respectfully submitted,

9/23/08  
Date

  
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